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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,433	03/12/2004	Soichi Homma	04329.3269	6546
22852	7590	07/19/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SANDVIK, BENJAMIN P	
			ART UNIT 2826	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/798,433	HOMMA, SOICHI	
	Examiner	Art Unit	
	Ben P. Sandvik	2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-21,23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) 9-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-8,21,23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 3/29/2007 have been fully considered but they are not persuasive. The newly amended limitations to claims 1, 21, and 23 are directed to "product by process" claim as detailed in the rejection below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6, 7, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capote et al (U.S. Patent #6121689), in view of Lin (U.S. Patent #6426556).

With respect to **claim 1**, Capote teaches a semiconductor chip having a semiconductor element or an integrated circuit formed in the semiconductor chip (Fig. 15, 10), a low dielectric constant insulating film having a relative dielectric constant of about 3.5 or less formed directly on a surface of the dielectric chip (Col 10 Ln 40-41; benzocyclobutene, which is disclosed in the specification of this application to be a suitable material. It is inherent that benzocyclobutene has a dielectric constant of about 3.5 or less); a plurality of bump electrodes (Fig. 15, 14) provided on a surface of the insulating, a wiring board (Fig. 15, 20) having a

plurality of connecting electrodes being electrically connected to the bump electrodes (Fig. 15, 12); and a resin molding filled in a space between the semiconductor chip and the wiring, the electrically connected bump electrodes and the connecting electrodes being arranged in the space (Fig. 15, 22), wherein the resin molding is formed a resin having a flux function and changed from liquid to solid when the bump electrodes are in a molten state (Col 4 Ln 14-24); and that the resin has a coefficient of elasticity of greater than 20 MPa (Col 10 Ln 56-57). Capote does not teach a low dielectric constant insulating film formed on a surface of the semiconductor chip, and additionally a passivation film formed on a surface of the low dielectric constant insulating film. Lin teaches a dielectric insulating film on a semiconductor surface (Fig. 15, 29), a passivation film formed on the insulating film (Fig. 15, 32), and that the passivation film can comprise multiple layers (Col 6 Ln 31-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an additional passivation film on the film of Capote as taught by Lin in order to provide additional surface protection for the chip.

Furthermore, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all

of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear. As to the grounds of rejection under section 103, see MPEP § 2113.

With respect to **claim 3**, Capote teaches a low dielectric constant insulating film benzocyclobutene, which is disclosed in the specification of this application to be a suitable material. It is inherent that benzocyclobutene has an adhesion strength of 15 J/m² or less.

With respect to **claim 6**, Capote teaches a resin molding comprising a first resin layer close to the semiconductor chip (Fig. 13, 37) and a second resin layer close to the wiring board (Fig. 13, 39), and the second resin layer is a resin layer which does not contain a filler (Col 9 Ln 31-32).

With respect to **claim 7**, Capote teaches a resin molding comprising a first resin layer close to the semiconductor chip (Fig. 15, 32), a second resin layer close to the wiring board (Fig. 15, 34), and a third resin layer interposed between the first resin layer and the second resin layer (Fig. 15, 22), and the third resin layer is a resin layer which does not contain filler (Col 9 Ln 55-56, portion 39 contains no filler).

With respect to **claim 27**, Capote teaches a low-k dielectric film of silicon nitride (Col 10 Ln 41).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capote and Lin, in view of Mistry et al (U.S. Patent #6077726).

With respect to **claim 8**, Capote and Lin teach all of the limitations of claim 1, and furthermore Capote teaches that the bump electrodes of the semiconductor chip are electrically connected to a plurality of connecting electrodes formed on the semiconductor chip (Fig. 4, 24), but does not teach that a part of the connecting electrodes are coated with a passivation film comprising at least one layer formed of an organic film. Mistry teaches a passivation film comprising at least one layer formed of an organic film coating a connecting electrode (Fig. 1, 16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Capote with a passivation layer of organic material as taught by Mistry in order to reduce stress in the package.

Claims 21, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capote et al (U.S. Patent #6121689), in view of Lin (U.S. Patent #6426556), further in view of Grill et al (U.S. PG Pub #2002/0127844).

With respect to **claims 21, 25, and 28**, Capote teaches a semiconductor chip in which a semiconductor element or an integrated circuit is formed (Fig. 15, 10); a passivation film formed on the chip (Col 10 Ln 40-41), a pad (Fig. 3, 24); and a bump electrode formed on the pad through the barrier film (Fig. 15, 14);

but does not teach a low K dielectric film formed on the semiconductor chip, the low K dielectric film having a wiring film formed therein; or a barrier film formed on the pad; a wiring board (Fig. 15, 20) having a plurality of connecting electrodes being electrically connected to the bump electrodes (Fig. 15, 12); and a resin molding filled in a space between the semiconductor chip and the wiring, the electrically connected bump electrodes and the connecting electrodes being arranged in the space (Fig. 15, 22), wherein the resin molding is formed a resin having a flux function and changed from liquid to solid when the bump electrodes are in a molten state (Col 4 Ln 14-24); and that the resin has a coefficient of elasticity of greater than 20 MPa (Col 10 Ln 56-57). Grill teaches chip having a low-K dielectric film (Fig. 3, 310 and Paragraph 61) and wiring film formed thereon (Paragraph 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide low-K insulating films on the chip of Capote in order to reduce signal propagation delays in the device. Lin teaches a barrier film formed on a pad (Fig. 15, 33 and Col 11 Ln 5-6); the barrier film formed of gold (Col 10 Ln 27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a barrier layer on the pad of Capote in order to prevent oxidation.

Furthermore, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In

re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear. As to the grounds of rejection under section 103, see MPEP § 2113.

Claims 23, 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capote et al (U.S. Patent #6121689), in view of Kelkar et al (U.S. Patent #6462426), further in view of Grill et al (U.S. PG Pub #2002/0127844).

With respect to **claims 23, 26, and 29**, Capote teaches a semiconductor chip in which a semiconductor element or an integrated circuit is formed (Fig. 15, 10); a passivation film formed on the chip (Col 10 Ln 40-41), a pad (Fig. 3, 24); and a bump electrode formed on the pad through the barrier film (Fig. 15, 14); a wiring board (Fig. 15, 20) having a plurality of connecting electrodes being electrically connected to the bump electrodes (Fig. 15, 12); and a resin molding filled in a space between the semiconductor chip and the wiring, the electrically connected bump electrodes and the connecting electrodes being arranged in the space (Fig. 15, 22), wherein the resin molding is formed a resin having a flux function and changed from liquid to solid when the bump electrodes are in a

molten state (Col 4 Ln 14-24); and that the resin has a coefficient of elasticity of greater than 20 MPa (Col 10 Ln 56-57); but does not teach a low K dielectric film formed on the semiconductor chip, the low K dielectric film having a wiring film formed therein; a plurality of passivation films, each of the passivation films having a pad of a different material formed therein; or a barrier film formed on the pad. Grill teaches chip having a plurality low-K dielectric films (Fig. 3, 310 and Paragraph 61) and wiring film formed thereon (Paragraph 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide low-K insulating films on the chip of Capote in order to reduce signal propagation delays in the device.

Kelkar teaches a plurality of passivation layers having a pad of different material formed therein (Fig. 2, passivation films 206 and 210, pads 204 and 202, materials Col 4 Ln 64-66 and Col 6 Ln 11-13, the materials are distinguished from another by being formed separately and by the difference in shading in the drawings); and a barrier film formed in the uppermost passivation film (Fig. 2, 212) formed from nickel (Col 5 Ln 43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a plurality of passivation films and pads on the device of Capote as taught by Kelkar in order to prevent cracks from propagating through the package (Col 4 Ln 36); and to provide a barrier film on the device of Capote as taught by Kelkar in order to provide a contact area for the solder bump. Furthermore, it would have been obvious to one of ordinary skill in the art to select different material for the pads

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202 and 204, such as copper and aluminum, since different material were disclosed by Kelkar. See MPEP 2144.06; an express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Furthermore, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear. As to the grounds of rejection under section 103, see MPEP § 2113.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ben P. Sandvik whose telephone number is (571) 272-8446. The examiner can normally be reached on Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue Purvis can be reached on 571-272-1236. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bps



EVAN PERT
PRIMARY EXAMINER